



United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,152	03/26/2001	William A. Knaus	031672.0004	6441
7590 01/31/2006		EXAMINER		
James Remenick			NAJARIAN, LENA	
Powell Goldstei	in LLP			
Intellectual Property Group			ART UNIT	PAPER NUMBER
901 New York Avenue NW Third			3626	
Washington, DC 20001			DATE MAILED: 01/31/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.	Applicant(s)		
09/816,152	KNAUS ET AL.		
Examiner	Art Unit		
Lena Najarian	3626		

Advisory Action	09/816,152	KNAUS ET AL.	
Before the Filing of an Appeal Brief	Examiner	Art Unit	_
	Lena Najarian	3626	
The MAILING DATE of this communication appe	ars on the cover sheet with the c	orrespondence address	
THE REPLY FILED 01 November 2005 FAILS TO PLACE THIS		*	
1. The reply was filed after a final rejection, but prior to or on this application, applicant must timely file one of the follow places the application in condition for allowance; (2) a No a Request for Continued Examination (RCE) in compliance time periods:	the same day as filing a Notice of ving replies: (1) an amendment, aff tice of Appeal (with appeal fee) in ce with 37 CFR 1.114. The reply mu	Appeal. To avoid abandonment of idavit, or other evidence, which compliance with 37 CFR 41.31; or (3	
a) The period for reply expiresmonths from the mailing b) The period for reply expires on: (1) the mailing date of this A no event, however, will the statutory period for reply expire la Examiner Note: If box 1 is checked, check either box (a) or TWO MONTHS OF THE FINAL REJECTION. See MPEP 7	dvisory Action, or (2) the date set forth ater than SIX MONTHS from the mailing (b). ONLY CHECK BOX (b) WHEN THE	g date of the final rejection.	ln
Extensions of time may be obtained under 37 CFR 1.136(a). The date have been filed is the date for purposes of determining the period of ex under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the set forth in (b) above, if checked. Any reply received by the Office later may reduce any earned patent term adjustment. See 37 CFR 1.704(b) NOTICE OF APPEAL	on which the petition under 37 CFR 1.1 tension and the corresponding amount shortened statutory period for reply origing than three months after the mailing date.	of the fee. The appropriate extension fe nally set in the final Office action; or (2) te of the final rejection, even if timely file	e as ed,
 The Notice of Appeal was filed on A brief in comp filing the Notice of Appeal (37 CFR 41.37(a)), or any exte a Notice of Appeal has been filed, any reply must be filed AMENDMENTS 	nsion thereof (37 CFR 41.37(e)), to	avoid dismissal of the appeal. Since	of e
3. The proposed amendment(s) filed after a final rejection, (a) They raise new issues that would require further co (b) They raise the issue of new matter (see NOTE belo (c) They are not deemed to place the application in bet appeal; and/or (d) They present additional claims without canceling a NOTE: See Continuation Sheet. (See 37 CFR 1.1 The amendments are not in compliance with 37 CFR 1.15. Applicant's reply has overcome the following rejection(s)	nsideration and/or search (see NOw); w); ter form for appeal by materially recorresponding number of finally rejude and 41.33(a)). 21. See attached Notice of Non-Co	TE below); ducing or simplifying the issues for ected claims.	
 6. Newly proposed or amended claim(s) would be all non-allowable claim(s). 7. For purposes of appeal, the proposed amendment(s): a) 	lowable if submitted in a separate,	· ·	те
how the new or amended claims would be rejected is provided in the claim (s) is (or will be) as follows: Claim (s) allowed: NONE. Claim (s) objected to: NONE. Claim (s) rejected: 1-59. Claim (s) withdrawn from consideration: NONE. AFFIDAVIT OR OTHER EVIDENCE	win not be entered, or by will will will will will will be entered, or by will will will be entered, or by will will be entered, or by will will be entered, or by will be entered and or b	i be entered and an explanation of	
 The affidavit or other evidence filed after a final action, bu because applicant failed to provide a showing of good and was not earlier presented. See 37 CFR 1.116(e). 	d sufficient reasons why the affidav	it or other evidence is necessary an	ıd
 The affidavit or other evidence filed after the date of filing entered because the affidavit or other evidence failed to c showing a good and sufficient reasons why it is necessard. The affidavit or other evidence is entered. An explanation REQUEST FOR RECONSIDERATION/OTHER 	vercome <u>all</u> rejections under appea y and was not earlier presented. So	al and/or appellant fails to provide a ee 37 CFR 41.33(d)(1).	
 The request for reconsideration has been considered bu See Continuation Sheet. 	t does NOT place the application in	condition for allowance because:	
12. ☑ Note the attached Information Disclosure Statement(s). (13. ☐ Other:	(PTO/SB/08 or PTO-1449) Paper N	o(s). <u>20050923</u>	
	JOSEPH THOMAS UPERVISORY PATENT EXAMI	NER	

U.S. Patent and Trademark Office PTOL-303 (Rev. 7-05)

Continuation Sheet (PTO-303)

Application No. 09/816,152

Continuation of 3. The proposed amendment to claim 40 changes the scope of the claim from that previously presented in reciting a new class of invention and requires further consideration.

Continuation of 11.

(1) Applicant argues at page 14 that claim 37 is not a method claim, but a product-by-process claim and is in proper form.

As per the first argument, applying the infringement test to determine whether a dependent claim is proper, it is conceivable that the product claim can be infringed without infringing the base method claim if the product can be made by a method other than that recited in the base method claim. Thus, claim 37 fails the infringement test since it is directed to both a method (through dependency) and a product (see page 2 of Non-Final Rejection mailed 6/17/05). Note also MPEP 2173.05(p).

(2) At page 14 Applicant states that claim 40 is now statutory.

As per this remark, Applicant is arguing features that have not been entered.

(3) At page 15, Applicant argues that Segal and Malik are not prior art in view of Applicant's Rule 131 Declaration.

The Examiner would like to thank the Applicant for providing a claim chart to assist the Examiner. However, the 131 Declaration is insufficent to remove the applied references since the "Claim Chart" does not adequately match the claims with the averred statements for at least three features. For example, clear support for the claimed features of: (i) broad-band, (ii) non-repudiation, and (iii) the "only" phrase (in line 10 of claim 1) were not found in the cited passages of Applicant's exhibits.

(4) At page 16, Applicant points to a passage in the MPEP to argue that the affidavit may be compared with the prior art reference. At page 17, Applicant points to another passage of the MPEP to argue that a comparison between the affidavit and the PTO's interpretation of the invention is permissable.

The Examiner agrees that these passages are in the MPEP, however they have been taken out of context. The Examiner never required a showing of identical subject matter to the applied references. Applicant fails to sufficiently show that his invention "as claimed" was completed prior to the date of the applied references. The issue is not whether the affidavit shows more than what the references show, but rather, what invention did Applicant possess as of the dates averred. There is no clear nexus between several of the claimed features and the averred exhibits. For example, with respect to the "non-repudiation" feature recited in claim 1, Applicant points to various paragraphs of pp. 4, 8, 10, 11, 12, 13, 17, and 24 of exhibits yet, none of the cited passages directly refers to a "non-repudiation" characteristic: Similar analysis holds for at least the features of "broad-band" (claim 1, preamble) and "transmitted in whole or in part only to that person..." (claim 1, line 10).

(5) At pages 18-20, Applicant argues that the Examiner is construing claim terms, but is doing so without referring to Applicant's specification.

As per this argument, the Examiner gave each term the broadest reasonable interpretation in light of the Applicant's specification. The Examiner disagrees that she did not refer to the specification. The Examiner did refer to the specification, but was unable to find any definition given with precision, clarity, and deliberateness to warrant the meanings currently argued by Applicant. For example, at page 19, note the passages relied upon by Applicant for "certification." Applicant's definition of "certification" contains exemplary or non-committal phraseology such as "may be," "may," and "for example." Similar analysis applies for Applicant's definition of "non-repudiation." Note also MPEP 2111.01 and 2173.05(a).

(6) At pages 20-21, Applicant argues that the affidavit removes obvious-type prior art.

As per this argument, the Examiner respectfully disagrees, since the issue is not whether Applicant shows more than what the references show, but rather does the affidavit clearly demonstrate possession of the claimed invention. In addition, it is noted that the cited portion of the MPEP refers to a situation where there is no citation of a reference for a particular feature or modification. This is not the case at present, since the Examiner has pointed to specific passages of the applied reference for each and every limitation.

(7) At page 21, Applicant argues that Malik has been removed as prior art.

The Examiner disagrees. See reasons above in part (3).